REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claims 21-46 have been amended to be directed to processes for preparation of a cellulose acetate film. Claims 21, 22, 28-31, 37-40 and 43-45 have been amended for readability purposes in light of the amendments of such claims to be directed to processes for preparation of a cellulose acetate film.

In the Official Action, claims 21-46 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,705,632 (*Shimoda et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

At page 2 of the Official Action, the Patent Office has taken the position that features recited in the claims which describe the manner in which the cellulose acetate films are prepared, should not be given patentable weight because the claims are directed to films and not processes. Without addressing the propriety of the Patent Office's assertion in this regard, it is respectfully noted that the claims have been amended to be directed to processes for the preparation of a cellulose acetate film. Applicants submit that the recited process claims are now allowable over *Shimoda et al*, in light of the fact that *Shimoda et al* fails to disclose or suggest each process step recited in the claims. Such deficiencies of *Shimoda et al* are discussed below in greater detail.

Independent claim 21 is directed to a process for preparation of a cellulose acetate film comprising cellulose acetate having an acetic acid content in the range of 55.0 to 58.0%, the process comprising preparing a cellulose acetate solution according to a cooling

dissolution method and forming the film by a solvent casting method using the cellulose acetate solution.

Shimoda et al does not disclose or suggest each feature recited in claim 21. For example, *Shimoda et al* does not disclose or suggest a process for preparation of a cellulose acetate film comprising cellulose acetate having an acetic acid content in the range of 55.0 to 58.0%, the process comprising preparing a cellulose acetate solution according to a cooling dissolution method, as recited in claim 21.

As discussed in the previously filed Amendment, *Shimoda et al* discloses that cellulose acetate having an average acetic acid content of not more than 58.0% can be dissolved in acetone without use of a cooling dissolution method (col. 3, lines 51-54). That is, in stark contrast with process claim 21, *Shimoda et al* has no recognition or suggestion of a process for preparing a cellulose acetate having the claimed acetic acid content and wherein the process comprises preparing a cellulose acetate solution according to a cooling dissolution method.

For at least the above reasons, it is apparent that claim 21 is not rendered obvious over *Shimoda et al*.

Independent claim 31 is directed to a process for preparation of a cellulose acetate film comprising cellulose acetate having an acetic acid content in the range of 58.0 to 62.5%, the process comprising preparing a cellulose acetate solution according to a cooling dissolution method, forming a film by a solvent casting method using the cellulose acetate solution, and stretching the film.

Shimoda et al does not disclose or suggest each feature recited in claim 31. For example, *Shimoda et al* does not disclose or suggest a process for preparation of a cellulose acetate film comprising stretching a film formed by a solvent casting method, as recited in

claim 31. In this regard, the Patent Office previously stated the following at page 4 of the Official Action issued December 20, 2004:

> . . . it is known in the art that stretching treatment of a cellulose acetate film is carried out in order to control its retardation and the stretch ratio is desirably 3-100%. Therefore, it would have been obvious to one of ordinary skill in the art at the time of [sic] the invention was made to stretch the cellulose acetate film at a desirable stretch ratio such as 10-30% in either the length or width direction to control its retardation and thus to obtain an efficient film.

Contrary to the above assertion, however, *Shimoda et al* provides no disclosure or suggestion of a "stretching treatment of a cellulose acetate film [that] is carried out in order to control its retardation", nor is there any disclosure or suggestion of a desirable stretch ratio.

To the extent that the Examiner has taken Official Notice concerning the stretching treatment described in the Official Action at page 4, Applicants respectfully traverse such assertion. In this regard, M.P.E.P. §2144.03 states the following:

> It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known [emphasis in original].
>
> * * *
>
> It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based [emphasis added].

In the present case, the Examiner has asserted that it is known in the art that stretching treatment of a cellulose acetate film is carried out in order to control its retardation and the stretch ratio is desirably 3-100%. However, absent any evidentiary support, the facts asserted by the Examiner are not capable of instant and unquestionable demonstration as being well-known. Thus, for at least the reasons discussed above, Applicants respectfully traverse the Examiner's Official Notice to the extent such assertion has been made.

For at least the above reasons, it is apparent that *Shimoda et al* does not disclose or suggest each feature recited in claim 31.

Independent claim 40 is directed to a process for preparation of a cellulose acetate film comprising cellulose acetate having an acetic acid content in the range of 58.0 to 62.5%, the process comprising preparing a cellulose acetate solution according to a cooling dissolution method using a halogenated hydrocarbon as a solvent, and forming the film by a solvent casting method using the cellulose acetate solution.

Shimoda et al does not disclose or suggest each feature recited in claim 40. For example, *Shimoda et al* does not disclose or suggest a process for preparation of a cellulose acetate film, comprising preparing a cellulose acetate solution according to a cooling dissolution method using a halogenated hydrocarbon as a solvent, as recited in claim 40.

The Patent Office has asserted that *Shimoda et al* discloses the use of a halogenated hydrocarbon such as methylene chloride in the cooling dissolution method thereof (Official Action at page 3). However, upon a complete review and fair reading of the *Shimoda et al* patent, it is apparent that *Shimoda et al* teaches away from the use of a halogenated hydrocarbon in the cooling dissolution method thereof. *Shimoda et al* discloses that the use of hydrocarbon halides such as methylene chloride raises various concerns, and that as a result "it is an urgent necessity to search for a new solvent for the cellulose acetate" (col. 2, lines 18-29). Moreover, *Shimoda et al* discloses that "[a]n object of the present invention is to form an excellent cellulose acetate film without use of organic chloride solvents such as methylene chloride" (col. 3, lines 9-11). *Shimoda et al* also discloses that as a result of the process disclosed therein, "an excellent cellulose acetate film can be prepared according to the present invention without use of methylene chloride" (col. 16, lines 34-36). In light of the fact that *Shimoda et al* teaches away from the use of a halogenated hydrocarbon as a solvent,

Shimoda et al fails to disclose or suggest preparing a cellulose acetate solution according to a cooling dissolution method using a halogenated hydrocarbon as a solvent, as recited in claim 40.

For at least the above reasons, it is apparent that no *prima facie* case of obvious exists over *Shimoda et al*. Accordingly, withdrawal of the above §103(a) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL PC (INCLUDING ATTORNEYS FROM BURNS, DOANE, SWECKER & MATHIS)

Date: December 5, 2005

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